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09/527,019 03/16/00 ELLIS

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EXAMINER

021967
HUNTON AND WILLIAMS
1900 K STREET N W
WASHINGTON DC 20006

QM22/0411

STASHICK, A
ART UNIT

PAPER NUMBER

3728
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04/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/527,019

Applicant(s)

ELLIS, FRAMPTON E.

Examiner

Anthony D Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mechanical fasteners, a snap fit and "combinations thereof", as stated in claim 4 and the "microcomputer in electrical communication with ..." in claim 6, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Furthermore, some or much of the subject matter disclosed appears to be entirely outside the bounds of the claims and is therefore unnecessary to support the instant invention. Under provisions of MPEP 1302.01, the applicant is requested to modify the application to restrict the descriptive matter and Figures so as to be in harmony with the claims.

Currently, it appears that only Figures 11A-11P support the instant invention.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 for failing to provide a sufficient written description and an enabling disclosure for a removable midsole orthotic insert which forms at least a portion of the rounded surface to support the embodiment of claim 3.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4 and 7 contain the word "non-orthotic" which renders the claim vague and indefinite. It is unclear as to what is meant to be encompassed by this limitation in the claims. Any insertion into the inside of a shoe performs some orthotic function, i.e. support, cushioning. Claim 1 is indefinite and inaccurate as the upper does not "envelopes, on the outside..." the midsole. It appears that the upper and the midsole abut each other only minimally at the periphery. Also, with respect to claim 1, the use of the phrase "relative to an intended wearer's foot location inside the shoe" in line 9 of the claim is unclear. It is unclear how one is able to describe the concavity with respect to a user's foot location in the shoe when different feet of the same size may be located differently within the shoe. With respect to claim 3, the preamble including the phrase "...or other footwear, such as an athletic shoe or street shoe..." renders the claim vague and indefinite. It is not clear what this phrase is meant to encompass or what are the metes and bounds of the claim. Also, the "being concavely rounded relative to an

Art Unit: 3728

intended wearer's foot location inside the shoe" in lines 4-5 of the claim renders it vague and indefinite. It is not clear as to what structure is meant to be encompassed by this phrase. In claim 3, the phrase "said midsole includes an non-orthotic insert which is removable from said shoe sole" is unclear inasmuch as the midsole (145) appears to be the insert that is removable and therefore the midsole cannot comprise an insert. In claim 3, line 3, it is not clear what "inner surface" and "outer surface" applicant is referring to, the surfaces of the bottom sole, midsole, or both.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Vizy et al. 6,023,857.

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yung-Mao 4,845,863. Yung-Mao '863 teaches a shoe comprising a removable midsole (10) being releasably secured to said outsole by equivalent releasable securing structure (segment 30 (54, 56, 58)).

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Molloy 597,524. Molloy discloses all the limitations of the claims including a shoe having an upper (a) being attached to the bottom sole (b) such that the shoe upper envelopes the midsole on the outside. the midsole (d) being removable and curved (see cross-section, Figure 1).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/03080 (Ellis '080) in view of Vizy '857 or Yung-Mao '863. Ellis discloses a shoe comprising a midsole substantially as claimed (see Figure 15A), but does not teach the midsole being removable. Vizy '857 and Yung-Mao '863 both teach that a midsole in a shoe can be removable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the shoe of Ellis '080 with a removable midsole, as taught by Vizy '857 or Yung-Mao '863, to aid in replacing the midsole when it gets worn or placing different midsoles within the shoe to adjust the comfort to the user's desires.

12. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Demon 5,813,142. The references as applied to claim 1 above disclose all the limitations of the claims except for the compartment containing a fluid, a flow regulator a duct, a control system that automatically adjusts the pressure in the compartment, and a microcomputer. Demon '142 teaches that a shoe sole can be modified to contain a compartment containing a fluid, a flow regulator, a duct, a control system automatically adjusting the pressure in the compartment, and a microcomputer, substantially as claimed. Therefore, it would have been obvious to provide the shoe sole of the references as applied to claim 1 above with the system of Demon 142 to reduce the impact of the user's foot on the traveling surface during use. With respect to claim 7, the

Art Unit: 3728

midsole is "capable" of being permanently affixed as any sole is capable of being glued, sewn or otherwise permanently affixed to the shoe.

Double Patenting

13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 1-10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11-44 of copending Application No. 09/375,480. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-44 of U.S. Patent No. 09/358,848. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is not

Art Unit: 3728

clear what is meant by a "non-orthotic" insert when any insert placed within a shoe performs some orthotic function.

Conclusion

17. Upon searching the instant application, the Examiner discovered the other applications noted in the Double Patenting rejections above. Applicant is respectfully reminded of the duty to disclose to the Office any applications pertinent to the prosecution of the instant application according to 37 CFR 1.56.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T. Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Anthony D Stashick
Examiner
Art Unit 3728

ADS
April 8, 2001